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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/282,893	03/31/1999	DARYL C. CROMER	RP9-99-005	9241

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EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/282,893

Applicant(s)

CROMER ET AL.

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed May 28, 2004 with respect to claims 1-20 have been fully considered but they are not persuasive.

Regarding claim 1, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a call occurs based on a condition that a tracked position has not violated boundary conditions) are not recited in the rejected claim(s). See argument, page 8, second full paragraph. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 currently reads that the calling function occurs "when the position has not violated the boundary conditions", and does not condition the occurrence of the calling function solely to the non-violation of the boundary conditions. Therefore, the claim as currently written does not preclude occurrence of the calling function when the boundary conditions are violated. "When" is a broader term than "based on" – "when" requires only that the boundary non-violation and calling function occur at the same time, not that the calling function is exclusively conditioned on, or made in response to, a boundary non-violation.

Furthermore, there is not support in the specification as originally filed for conditioning the calling function on a non-violation of the boundary conditions. Page 8, lines 15-18 of the specification disclose that "while the boundary check facility is enabled, a call is made from the portable computer... at preset intervals, such as once a

day.” The specification does not disclose that the calling function is disabled when a boundary violation occurs.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1, 2, and 5-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertel (U.S. Patent No. 5,532,690) in view of Cotichini et al. (U.S. Patent No. 6,300,863) and Klein (U.S. Patent No. 5,936,526).

Regarding claim 1, Hertel teaches a method for providing protection against theft and loss of a vehicle. The method comprises: establishing boundary conditions within which the vehicle is authorized for use; tracking a position of the vehicle with a GPS unit in the vehicle; comparing the position to the boundary conditions to identify whether the vehicle has violated the boundary conditions; and performing anti-theft routines when the position has violated the boundary conditions. See Abstract. Hertel does not disclose that the method is used in a portable computer system, or that the method comprises utilizing a preset calling function at preset intervals to identify a location of the portable computer system based on GPS data from the GPS unit when the position has not violated the boundary conditions. However, Cotichini discloses a method for providing protection against theft and loss of a portable computer system. Cotichini discusses the problem of portable computer theft and the need to provide protection

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against it. See col. 1, lines 20-25. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hertel's method with a portable computer system, in order to prevent its theft.

Cotichini also discloses that the method comprises utilizing a preset calling function at preset intervals to identify a location of the portable computer system. See col. 2, lines 27-54 and col. 8, lines 52-63. If the portable computer system was reported as being stolen, the calling function allows the owner to recover the portable computer system. See col. 14, lines 38-47. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel with Cotichini, such that the method comprises utilizing a preset calling function at preset intervals to identify a location of the portable computer system when the position has not violated the boundary conditions, in order to allow the portable computer system to be recovered by its owner if the portable computer system has been stolen but has not violated the boundary conditions.

Cotichini does not disclose that the location of the portable computer system is based on GPS data from a GPS unit. Instead, Cotichini discloses that the location is based on caller ID. See Abstract. However, Klein discloses a method for providing protection against theft of a portable computer system, in which the location of the portable computer system is identified by utilizing a calling function and is based on GPS data from a GPS unit in the portable computer system. See Figure 3 and col. 5, lines 60 through col. 6, line 1. One of ordinary skill in the art at the time of the invention would have recognized that GPS coordinates can provide a more precise description of

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a location than caller ID can. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel in view of Cotichini with Klein, such that the location of the portable computer system is based on GPS data from a GPS unit, in order to provide the owner of the portable computer system with a more precise description of the location of the portable computer system.

Regarding claim 2, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 1. Klein also discloses that performing anti-theft routines may comprise calling a preset phone number (e.g., a home telephone number) with a cellular calling facility (mobile telephone 324) of the portable computer system. See col. 5, line 60 through col. 6, line 1 and col. 7, lines 12-15.

Regarding claim 5, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 1. Hertel's tracking also inherently comprises reporting the position of the portable computer system at preset intervals.

Regarding claim 6, Hertel teaches a method for providing protection against theft and loss of a vehicle. The method comprises: utilizing GPS functionality within a vehicle to track a position of the vehicle; identifying when the position tracked by the GPS functionality violates preset boundary conditions of the vehicle; and utilizing calling functionality within the vehicle to report a potential theft of the vehicle when the preset boundary conditions have been violated. See col. 5, lines 15-67. Hertel does not disclose that the method is used in a portable computer system, or that the method comprises utilizing a preset calling function at preset intervals to identify a location of the portable computer system when the position has not violated the boundary

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conditions. However, these features are taught by Cotichini, as explained in the preceding rejection of claim 1, and it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hertel to include these features, for the same reasons mentioned in the rejection of claim 1.

Hertel and Cotichini do not teach that the calling functionality of the portable computer system is cellular. However, Klein discloses a method for providing protection against theft of a portable computer system, in which cellular calling functionality within the portable computer system is utilized to identify a location of the portable computer system. See col. 5, line 60 through col. 6, line 1 and col. 7, lines 12-15. One of ordinary skill in the art at the time of the invention would have recognized that the preponderance of long distance calling functionalities utilized in modern portable computer systems were cellular, such as Klein's. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hertel in view of Cotichini with Klein, such that the calling functionality of the portable computer system is cellular, in order to implement the invention in a modern portable computer system with as little modification to the portable computer system as possible.

Regarding claim 7, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 6. Hertel also discloses that the method comprises establishing the preset boundary conditions as a chosen distance from a given location within which use of the vehicle is allowed. See col. 4, line 66 through col. 4, line 7.

Regarding claim 8, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 6. Hertel also discloses that the step of utilizing calling functionality

comprises calling a preset emergency phone number (e.g., a central monitoring station operated by the local police). See col. 5, lines 52-67.

Regarding claim 9, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 8. Hertel also discloses that the step of utilizing may comprise sending a location of the vehicle to the preset emergency phone number. See col. 5, lines 48-51.

Regarding claim 10, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 9, but does not teach that the location is sent as a data stream using facsimile protocol. However, the examiner takes Official notice that a facsimile protocol is a well known protocol for transmitting data across a wireless interface, and also that many portable computers are manufactured with the capability of transmitting facsimile information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel in view of Cotichini, such that the location is sent as a data stream using facsimile protocol, in order to utilize a portable computer system's built-in communication capabilities and thereby avoid extra expenses.

Regarding claim 11, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 6. Hertel also inherently utilizes the GPS functionality at regularly scheduled predetermined intervals.

Regarding claim 12, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 6. Furthermore, in using Hertel's method to provide protection against theft of a portable computer system, one of ordinary skill in the art would realize

that the GPS functionality can be utilized at all times, including during booting upon power-up of the portable computer system.

Regarding claim 13, Hertel teaches a communication control system for providing built-in anti-theft capabilities in a vehicle. The communication control system comprises: a controller (30); a wireless unit (36); a GPS unit (14) coupled to the controller for tracking a position of the vehicle; and a storage unit (16). The storage unit is coupled to the controller and stores preset boundary conditions and out-of-boundary actions. The controller compares the position to the boundary conditions and initiates the out-of-boundary actions when the comparison identifies a violation of the boundary conditions. See Abstract and Figure 1. Hertel does not disclose that the communication control system provides built-in anti-theft capabilities in a portable computer system, or that the wireless unit is a cellular unit for performing a calling function at preset intervals, where the calling function provides for an identification of a location of the portable computer system when there is not a violation of the boundary conditions.

However, Cotichini discloses a communication control system for providing built-in anti-theft capabilities in a portable computer system. Cotichini discusses the problem of portable computer theft and the need to provide protection against it. See col. 1, lines 20-25. It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hertel's communication control system in a portable computer system, in order to prevent its theft.

Cotichini also discloses that the communication control system comprises a wireless unit for performing a calling function at preset intervals, and that the calling function provides for an identification of a location of the portable computer system. See Figure 1; col. 2, lines 27-54; col. 6, lines 54-57; and col. 8, lines 52-63. If the portable computer system was reported as being stolen, the calling function allows the owner to recover the portable computer system. See col. 14, lines 38-47. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel with Cotichini, such that the wireless unit performs a calling function at preset intervals, and that the calling function provides for an identification of a location of the portable computer system, in order to allow the portable computer system to be recovered by its owner if the portable computer system has been stolen but has not violated the boundary conditions.

Hertel and Cotichini do not teach that the calling functionality of the portable computer system is cellular. However, Klein discloses a method for providing protection against theft of a portable computer system, in which a cellular unit within the portable computer system is utilized to identify a location of the portable computer system. See col. 5, line 60 through col. 6, line 1 and col. 7, lines 12-15. One of ordinary skill in the art at the time of the invention would have recognized that the preponderance of long distance wireless units utilized in modern portable computer systems were cellular, such as Klein's. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hertel in view of Cotichini with Klein, such that the wireless calling unit of the portable computer system is cellular, in order to implement the

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invention in a modern portable computer system with as little modification to the portable computer system as possible.

Regarding claim 14, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 13, and Hertel also discloses that the wireless unit may call a preset phone number (of a central monitoring station operated by the local police) as an out-of boundary action. See col. 5, lines 52-67.

Regarding claim 15, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 14, and Hertel also discloses that the wireless unit reports a location of the vehicle. See col. 5, lines 44-51.

Regarding claim 16, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 13. Hertel's GPS unit also inherently tracks the position at preset intervals.

Regarding claim 17, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 13. Hertel also discloses that the storage unit stores a predetermined distance from a central location as an in-bounds condition for the vehicle. See col. 4, line 66 through col. 4, line 7.

Regarding claims 18-20, Hertel in view of Cotichini and Klein teaches all of the limitations of claims 1, 6, and 13, and Cotichini discloses that the identified location is utilized as a report for finding the portable computer system if it is stolen. See col. 8, lines 52-63 and col. 14, lines 38-47.

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4. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hertel in view of Cotichini and Klein as applied to claim 1 above, and further in view of Isikoff (U.S. Patent No. 5,748,084).

Regarding claims 3 and 4, Hertel in view of Cotichini and Klein teaches all of the limitations of claim 1, but does not teach that the anti-theft routines comprise prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password. However, Isikoff teaches an anti-theft routine for a portable computer system that comprises prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password. See col. 4, lines 39-61. It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify Hertel in view of Cotichini and Klein with Isikoff, such that the anti-theft routines comprise prompting a user for a password, wherein operation of a portable computer system continues uninterrupted when the password matches a master password and operation of the portable computer system is disabled when the password does not match the master password, so that the anti-theft routines may be overridden by an authorized user.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

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(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

8/9/04

JKM

[Signature]
8/10/04
LESTER G. KINCAID
PRIMARY EXAMINER